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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,617	10/17/2003	Sumio Kamoi	244146US0	8956

22850 7590 06/07/2006

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EXAMINER	
KOSLOW, CAROL M	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/686,617	KAMOI ET AL.	
	Examiner	Art Unit	
	C. Melissa Koslow	1755	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) *27-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/13/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This action is in response to applicants' amendment of 28 April 2006. The amendments to the specification have overcome the objection to the disclosure and the 35 USC 112, first paragraph rejection. The 35 USC 112, second paragraph rejection with respect to the improper Jepson claim format and the size in claims 8, 13, 18 and 23 are withdrawn due to the amendments to the claims. Applicant's arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

This application contains claims 27-31 drawn to an invention nonelected with traverse in the response of 19 December 2005. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The reference crossed off in the information disclosure statement of 13 April 2006 is this application and thus should not be cited in an information disclosure statement.

It is noted that the status modifier for claim 28 is incorrect. T should be "(Withdrawn)".

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-26 are indefinite since the particle sizes applicants' consider as "fine" are not defined. The teaching that the resin particles are one-tenth the mean size of the magnetic particles do not give any guidance as to the particle size which applicants' considers as fine since the mean size of the magnetic particles is not defined in the claims.

The amendments to the claims did not overcome this rejection. Applicants' argument that the definition of "fine" is found throughout the specification is not supported. The sections

pointed to by application uses the term "fine" but never gives a particle size range which would indicate what particle sizes applicant considers as "fine". The rejection is maintained.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 34 of copending Application No. 10/820,052. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of claim 34 in the copending application teaches the claimed magnet compound material.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's comment with respect to this rejection is noted. The rejection is maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. patent 4,137,188.

This patent teaches a mixture of magnetic powder, thermoplastic resin particles, a pigment and a charge control agent. While the resin particle size is not taught, it is clear the resin particles are of such a size so as to allow the mixture to be thoroughly mixed and thus they are fine. The compositional mixture clearly teaches the claimed mixture.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,137,188.

As stated above, this reference teaches the claimed mixture. The reference teaches the thermoplastic resin has a softening temperature in the range of 60-120°C (col. 5, lines 67-68), which overlaps the claimed range. The reference suggests the claimed mixture.

Applicant's characterization of the Examiner's statement on page 5 is incorrect. The Examiner did not state the reference does not describe or require "fine" grains. The Examiner stated the reference did not teach the particle size of the taught thermoplastic grains but since the grains are of such a size so as to allow the mixture to be thoroughly mixed, they must be fine. Applicants have not presented any evidence that the taught grains are not fine, nor have they provided a clear definition as to what size range applicant considers as fine. The softening point of a resin is an inherent property of the resin. When this temperature occurs during processing is immaterial to the rejected claims. In response to applicant's argument as to purpose of the claimed resin grains, there has been no showing that the claimed grains are different from that taught. The rejection is maintained.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,342,557 or 6,338,900.

Both of these references suggest a magnetic composition comprising a mixtures of magnetic particles, fine thermoplastic particles and a pigment.

Claims 1 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 4,626,371.

This reference suggests a magnetic molding formed by compression molding, in a magnetic field, a mixture of magnetic particles, fine thermoplastic particles and a pigment.

Since there is no definition of fine particles in the claims, the taught resin particles are taken to be fine, which simply means small particles. Applicant has not presented any evidence that the taught particles are not fine. The rejections are maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
June 2, 2006

C. Melissa Koslow
Primary Examiner
Tech. Center 1700